

## REMARKS

### Amendments to the Claims:

Claim 1 has been amended as indicated herein above. The amendments to claim 1 consist of incorporating into claim 1 elements and/or limitations of claim 8. Claim 8 has therefore been canceled as being redundant in view of the amendments to claim 1.

Claim 6 has been amended to be consistent with the amendments to claim 1.

Claim 25 has been amended to include clarifying language. Support for the amendments to claim 25 are found at least in figure 5 of the drawings.

### Rejection of Claims Under 35 U.S.C. § 112:

Claims 1, 4-8, 14, and 25-28 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention. In making the rejections of claims 1, 4-8, 14, and 25-28 under 35 U.S.C. § 112, second paragraph, the Examiner states that, "[t]he claims recite an imaging apparatus but do not recite image forming means or components."

Claims 4, 5, 7, and 8 have been canceled, and the rejections of those claims are now moot.

In regard to claims 1, 6, and 14, the Applicant respectfully traverses the rejections of those claims under 35 U.S.C. § 112, second paragraph, on the grounds that those claims fully comply with the standard set forth under 35 U.S.C. § 112, second paragraph. Although claims 1 and 6 have been amended, those amendments have not been made in response to the rejections under 35 U.S.C. § 112, second paragraph.

The Applicant notes that "[t]he primary purpose of this requirement of definiteness of claim language [as set forth under 35 U.S.C. § 112, second paragraph] is to ensure that the scope of the claims is clear so the public is informed of the boundaries of what constitutes infringement of the patent." (MPEP 2173.) The Applicant notes further that, "[t]he essential inquiry pertaining to this requirement is whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity." (MPEP 2173.02.)

1 More specifically, "[i]f the scope of the invention sought to be patented cannot  
2 be determined from the language of the claims with a reasonable degree of certainty,  
3 a rejection of the claims under 35 U.S.C. § 112, second paragraph is appropriate.  
4 (Id.) Or, in other words, "[i]f the scope of the subject matter embraced by the claims  
5 is clear, and if applicants have not otherwise indicated that they intend the invention  
6 to be of a scope different from that defined in the claims, then the claims comply with  
35 U.S.C. § 112, second paragraph. (MPEP 2173.04.)

7 The Applicant contends that all of the claims fully comply with the  
8 requirements set forth in 35 U.S.C. § 112, second paragraph, because the Applicant  
9 has not otherwise indicated that he intends the invention to be of a scope different  
10 from that defined in the claims, and the scope of the subject matter of each and  
every claim is clear.

11 In regard to the Examiner's statement that, "[t]he claims recite an imaging  
12 apparatus but do not recite image forming means or components," the Applicant  
13 respectfully disagrees and contends that all of the Applicant's claims recite at least  
14 one component of an image-forming apparatus. Moreover, the Applicant is not  
15 aware of how the Examiner's statement relates to the requirements set forth under  
35 U.S.C. § 112, second paragraph.

16 It appears that the Examiner's statement suggests that the Applicant's claims  
17 should be amended so as to be made narrower by adding unspecified components.  
18 However, the Applicant notes that, "[b]readth of a claim is not to be equated with  
indefiniteness." (MPEP 2173.04.)

19 Thus, the Applicant contends that the issue of whether the Applicant's claims  
20 recite any given component is not relevant to a finding of indefiniteness under 35  
21 U.S.C. § 112, second paragraph. Instead, the "[a]cceptability of the claim language  
22 depends on whether one of ordinary skill in the art would understand what is  
claimed, in light of the specification." (MPEP 2173.05(b).)

23 The Applicant contends that one of ordinary skill in the art would understand  
24 what is claimed, in light of the Applicant's specification, and that amending the claims  
25 so as to recite additional components would not make the claims any more clear, but  
would only decrease the breadth of the claims.

The Applicant contends, for at least the reasons set forth above, that claims 1,  
4-8, 14, and 25-28 fully comply with the requirements of 35 U.S.C. § 112, second

1 paragraph. Accordingly, the Applicant respectfully requests that the rejections of  
2 those claims under 35 U.S.C. § 112, second paragraph, be withdrawn.

3 Rejection of Claims Under 35 U.S.C. § 102:

4 Claims 25 and 26 have been rejected under 35 U.S.C. § 102(b) as being  
5 anticipated by U.S. Patent 4,806,969 to Tomoyori et al. The Examiner contends that  
6 Tomoyori teaches a fusing device having a hot roller (44) and first (45B) and second  
7 (45A) pressure rollers (figure 5).

8 The standard for rejecting a claim under 35 U.S.C. § 102 is generally  
9 accepted to be that, "[a] claim is anticipated only if each and every element as set  
10 forth in the claim is found, either expressly or inherently described, in a single prior  
11 art reference," and/or that, "[t]he identical invention must be shown in as complete  
12 detail as is contained in the ... claim." (MPEP 2131.)

13 Claim 25 has been amended as indicated herein above. The Applicant  
14 respectfully contends that claim 25 is not anticipated by Tomoyori because each and  
15 every element of claim 25 is not found in Tomoyori, and/or because the identical  
16 invention is not shown in as complete detail as is contained in those claims.

17 Claim 25 recites at least the following elements and/or limitations:

18 *a print path that passes only between the hot roller and the first pressure  
19 roller; and,*

20 *a fusing circuit that branches from the print path after the first pressure roller  
21 and passes between the hot roller and the second pressure roller.*

22 That is, the Applicant contends that the issue of whether Tomoyori discloses a  
23 fusing device having a hot roller, a first pressure roller and a second pressure roller  
24 is irrelevant to the issue of whether Tomoyori anticipates claim 25, because  
25 Tomoyori does not disclose *a print path that passes only between the hot roller and  
the first pressure roller, and a fusing circuit that branches from the print path after the  
first pressure roller and passes between the hot roller and the second pressure  
roller.*

At most, Tomoyori discloses two separate print paths that do not diverge,  
converge, or otherwise intersect with one another.

Therefore, the Applicant contends that Tomoyori does not anticipate claim 25  
because Tomoyori does not disclose each and every element as set forth in claim 25

1 and/or because Tomoyori does not shown the identical invention in as complete  
2 detail as is set forth in claim 25.

3 Accordingly, the Applicant respectfully requests that the rejection of claim 25  
4 under 35 U.S.C. § 102 be withdrawn.

5 In regard to claim 26, that claim depends from claim 25 and therefore recites  
6 each and every element and/or limitation of claim 25. Thus, the Applicant contends  
7 that claim 26 is not anticipated by Tomoyori for at least the reasons set forth above  
with respect to the argument against the rejection of claim 25.

8 Accordingly, the Applicant respectfully requests that the rejection of claim 26  
9 under 35 U.S.C. § 102 be withdrawn.

10 Rejection of Claims Under 35 U.S.C. § 103:

11 Claims 1, 4-8, and 14 have again been rejected in the Office action under 35  
12 U.S.C. § 103(a) as being unpatentable over U.S. Patent 5,987,294 to Yoda et al. in  
view of U.S. Patent 6,078,760 to Abe et al.

13 In regard to claims 4, 5, 7, and 8, those claims have been canceled as shown  
14 above, and the rejections with respect to those claims are now moot.

15 In regard to claims 1, 6, and 14, the Applicant respectfully contends that those  
16 claims are nonobvious in view of the cited references for the reasons set forth below.

17 As a legal basis for the Applicant's arguments against the rejection of claims  
18 1, 6, and 14, the Applicant notes that, "[t]o establish a *prima facie* case of  
19 obviousness, three basic criteria must be met. First, there must be some suggestion  
20 or motivation, either in the references themselves or in the knowledge generally  
21 available to one of ordinary skill in the art, to modify the reference or to combine  
22 reference teachings. Second, there must be a reasonable expectation of success.  
Finally, the prior art reference (or references when combined) must teach or suggest  
all the claimed limitations. (MPEP 2142.)

23 Firstly, the Applicant respectfully contends that there is no suggestion or  
24 motivation, either in the references themselves or in the knowledge generally  
25 available to one of ordinary skill in the art, to combine the reference teachings, as is  
required for an obviousness rejection.

The Applicant notes that in accordance with MPEP 2143.01, a "statement that  
the modifications of the prior art to meet the claimed invention would have been well

1 with the ordinary skill of the art at the time the claimed invention was made because  
2 the references relied upon teach that all the aspects of the claimed invention were  
3 individually known in the art is not sufficient to establish a *prima facie* case of  
4 obviousness without some objective reason to combine the teachings of the  
5 references.” (MPEP 2143.01.) The Applicant notes further that, “the prior art must  
6 suggest the desirability of the claimed invention.” (Id.)

7 However, the only reason given in the Office action by the Examiner in regard  
8 to this requirement is a statement that, “[i]t would have been obvious to one of  
9 ordinary skill in the art at the time the invention was made to [combine the] teaching  
10 of Abe with the image forming device of Yoda to obtain matted or glossy images  
11 having excellent image quality.”

12 The Applicant respectfully contends that the Examiner's statement does not  
13 amount to an objective reason to combine the teachings of the references, as is  
14 required for a *prima facie* finding of obviousness. Thus, in regard to claims 1, 6, and  
15 14, the Applicant contends that the requirements of a *prima facie* case of  
16 obviousness have not been established because no suggestion or motivation, either  
17 in the references themselves or in the knowledge generally available to one of  
18 ordinary skill in the art, to combine the reference teachings has been provided.

19 Moreover, the Applicant notes that, while Abe discloses forming a glossy  
20 image, Yoda does not. That is, Yoda does not mention forming a glossy image, and  
21 thus it can be concluded that the apparatus of Yoda is not capable of forming a  
22 glossy image. The Applicant contends that there is no motivation to combine the  
23 teachings of Yoda and Abe because Yoda does not teach forming a glossy image.

24 Additionally, “[i]f the proposed modification would render the prior art invention  
25 being modified unsatisfactory for its intended purpose, then there is no suggestion or  
motivation to make the proposed modification.” (Id.)

26 The Applicant notes Yoda teaches that the imaging media sheet must pass  
27 through both pressure rollers (60, 70) in order for the image to be completely fixed to  
28 the imaging media sheet. (See Yoda, col. 13, lines 23-29.) That is, in accordance  
29 with Yoda, if the sheet of imaging media were to pass between the hot roller (50) and  
30 only the first pressure roller (60), the image would not be completely fixed to the  
31 image media sheet. Thus, in view of the premise that at least one intended purpose  
32 of Yoda is to satisfactorily fix an image to an imaging media sheet, then it follows that

1 modifying the apparatus of Yoda so that the sheet of imaging media passes between  
2 the hot roller and only one pressure roller would render the apparatus of Yoda  
3 unsatisfactory for its intended purpose because this results in incomplete fixing.

4 Furthermore, "[i]f the proposed modification or combination of the prior art  
5 would change the principle of operation of the prior art invention being modified, then  
6 the teachings of the references are not sufficient to render the claims *prima facie*  
obvious." (MPEP 2143.01.)

7 The Applicant notes that in accordance with the teaching of Abe, each  
8 successive time a sheet is exposed to the fixing device, the sheet is turned over  
9 because the purpose of Abe is to provide duplexing capability. (See figures 1, 3-6,  
10 and 8 of Abe.) However, this is contrary to the teaching of Yoda in accordance with  
11 which the sheet is not turned over when passing between the hot roller and the first  
12 pressure roller and the hot roller and the second pressure roller. Thus, to combine  
Abe with Yoda, the principle of operation of one or both of those references would be  
changed.

13 Therefore, the teachings of Abe and Yoda are not sufficient to render the  
14 Applicant's claims *prima facie* obvious because the proposed modification would  
15 change the principle of operation of the prior art invention being modified, and the  
16 proposed modification would render the prior art unsatisfactory for its  
intended purpose.

17 Secondly, the Applicant respectfully contends that the prior art reference (or  
18 references when combined) do not teach or suggest all the claimed limitations as is  
19 also required for an obviousness rejection.

20 Specifically, in regard to claim 1, that claim has been amended and recites at  
21 least the following elements and/or limitations:

22 *a shunting device configured to be operated to cause a given sheet of media  
to selectively pass either:*

23 *between the hot roller and only one pressure roller; or*

24 *between the hot roller and more than one pressure roller.*

25 The Applicant asserts that neither Yoda nor Abe, either individually or when  
combined, disclose the above elements and/or limitations contained in claim 1, and  
that claim 1 is therefore nonobvious in view of the cited prior art.

1 In regard to claim 6, that claim depends from claim 1. The Applicant notes  
2 that, "[i]f an independent claim is nonobvious under 35 U.S.C. 103, then any claim  
3 depending therefrom is nonobvious." (MPEP 2143.03.) Accordingly, the Applicant  
4 asserts that claim 6 is also nonobvious in view of the cited prior art for at least the  
5 reasons set forth above with respect to the arguments presented against the  
6 rejection of claim 1.

7 In regard to claim 14, that claim recites at least the following elements and/or  
8 limitations:

9 *a shunting device operatively located along the print path and configured to  
10 selectively divert a given sheet of media from the print path onto the fusing circuit,  
11 wherein:*

12 *when the shunting device diverts the given sheet of media onto the  
13 fusing circuit, the given sheet of media successively passes between the hot  
14 roller and each of the pressure rollers; and,*

15 *when the shunting device does not divert the given sheet of media onto  
16 the fusing circuit, the given sheet passes between the hot roller and only one  
17 of the pressure rollers.*

18 The Applicant asserts that neither Yoda nor Abe, either individually or when  
19 combined, disclose the above elements and/or limitations contained in claim 14, and  
20 that claim 14 is therefore nonobvious in view of the cited prior art.

21 For at least the reasons set forth above, the Applicant respectfully requests  
22 that the rejections of claims 1, 6, and 14 under 35 U.S.C. § 103 be withdrawn.  
23

24 Allowable Subject Matter:

25 The Examiner has indicated that claims 29 and 30 are allowed. The  
Examiner has also indicated that claims 27 and 28 would be allowable if rewritten to  
overcome the rejections under 35 U.S.C. § 112, second paragraph, and to include all  
of the limitations of the base claim and any intervening claims.

However, as indicated herein above, the Applicant has traversed the  
rejections of claims 27 and 28. Accordingly, claims 27 and 28 have not  
been rewritten.

1 New Claims:

2 New claims 31-36 have been added as shown above. Support for new claims  
3 31-36 is found in the Applicant's specification, including the drawing figures. No new  
4 matter has been added. The Applicant asserts that claims 31-36 are not anticipated  
5 by, and are nonobvious in view of, the cited prior art references.

6 Fee for Additional Claims:

7 A fee for additional independent claims is to be charged to Assignee's deposit  
8 account, as indicated in the attached Transmittal Letter.

9 **SUMMARY**

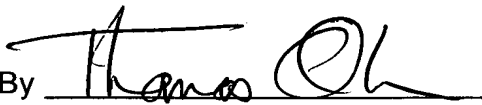
10 The Applicant believes this response constitutes a full and complete reply to  
11 the Office action mailed 10/06/2004. The Applicant further believes, for at least the  
12 reasons set forth above, that claims 1, 6, 14, and 25-36 are in allowable form, and  
13 therefore requests timely allowance of those claims.

14 The Examiner is respectfully requested to contact the below-signed attorney if  
15 the Examiner believes this will facilitate prosecution toward allowance of the claims.

16 Respectfully submitted,

17 Laurent A. Regimbal

18 Date: January 06, 2005

19 By 

20 Thomas Olson

21 Attorney for Applicant

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